



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,433	10/17/2005	Wassyl Nowicky	P/4637-11	6431
2352 7590 11/03/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
AULAKH, CHARANJIT				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
11/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,433

Applicant(s)

NOWICKY, WASSYL

Examiner

Charanjit S. Aulakh

Art Unit

1625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 9/15/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election of group I in paper filed on June 25, 2008 is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse; see MPEP 818.03(a).
2. Claims 26-62 are pending in the application.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 26-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following eight different factors (see *Ex parte Foreman*, 230 USPQ at 547; *Wands*, In re, 858.F. 2d 731, 8 USPQ 2d 1400, Fed. Cir. 1988) must be considered in order for the specification to be enabling for what is being claimed:

Quantity of experimentation necessary, the amount of direction or guidance provided, presence or absence of working examples, the nature of the invention, the state of the

prior art, the relative skill of those in the art, the predictability or unpredictability and the breadth of claims. In the instant case, the specification is not enabling based on at least four of the above mentioned eight different factors such as quantity of experimentation necessary, the amount of direction or guidance provided, presence of working examples, state of the prior art, unpredictability and the breadth of claims.

In regard to lack of enablement issue of instant claims 26-62 for derivatives (hydrates, solvates or prodrug forms) of instant compounds of formula (I), there is no teaching or guidance present in the specification for preparing any specific hydrates (mono, di, tri or tetra), solvates or prodrugs. Preparation of specific hydrates or solvates of any compound is a very specialized field and involves their characterization using different techniques such as infrared spectrum, XRD powder diffraction etc. There is no teaching or guidance present in the specification regarding any specific solvents used for preparing specific hydrates or solvates and their characterization using any techniques such as XRD powder diffraction or infrared spectrum etc. There is not even a single example present for preparing any specific hydrate or solvate of instant compounds of formula (I). There is lot of unpredictability regarding stability of different hydrates or solvates of any compound in the art. Therefore, in absence of such teachings, guidance, presence of working examples and unpredictability, it would require undue experimentation to select specific hydrates or solvates of instant compounds with enhanced stability properties.

In regard to prodrug forms, there is no teaching or guidance present in the specification for preparing specific types of prodrug form such carboxylic acid esters, amino acid or

amide esters, phosphate esters, phosphono esters , sulfate esters etc. There is not even a single working example present in the specification for preparing any type of specific prodrug form of instant compounds of formula (I). There is lot of unpredictability in the art for efficacy of different types of prodrug forms of any known compound following their in vivo administration since their efficacy depends upon various factors such as absorption from gut, metabolism by esterases etc. Therefore, in absence of such teachings, guidance, presence of working examples and unpredictability, it would require undue experimentation to select specific types of prodrug forms of instant compounds of formula (I) which will be effective following in vivo administration. In regard to enablement rejection of claims 57-62 for methods of treatment, the specification mentions various assays using compound, U-KRS on pages 12-22. First of all, it is not clear what is the structure of U-KRS? Is it same as compounds of formula (I)? Secondly, it is mentioned in various examples that the results show that U-KRS produced these specific effects. However, results are not present in any one of these examples. Therefore, in absence of such teachings, guidance, presence of working examples and prior art, it would require undue experimentation to demonstrate efficacy of instant compounds in known vitro cell lines or animal models of every known viral infection, cancer, immunological disease etc. and hence their utility for treating but not preventing (prophylaxis) these disorders.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 56 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 56 and 60, table 1 is mentioned. However, table 1 is not present in claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 52-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Zbierska (Herba Polonica).

Zbierska discloses anticancer and antibiotic properties of N-methylchelidonine (see summary on page 315). The compound disclosed in figure 1 (see page 313) and its anticancer as well as its antibacterial and antifungal activity (see tables 2-5 on pages 313-314) disclosed by Zbierska anticipates the instant claims when variable R1 represents methyl group in the instant compounds of formula (I).

9. Claims 26-51 and 57-60 are objected for containing non-elected subject matter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/
Primary Examiner, Art Unit 1625